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OFFICE OF PETITIONS

In re Application of	:	
Hall et al.	:	DECISION ON
Application No. 10/696,274	:	APPLICATION FOR
Filed: October 29, 2003	:	PATENT TERM ADJUSTMENT
Attorney Docket No.	:	
ICLS 1001-3	:	

This is a decision on the "PETITION TO COMMISSION (37 C.F.R. §1.705(e))," filed on May 2, 2009. Applicants request that the Patent Term Adjustment for the above-identified patent be increased from two hundred twenty-five (225) days to four hundred eighty-four (484) days.

The application for patent term adjustment patent is **DISMISSED**.

On April 1, 2009, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. § 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is two hundred twenty-five (225) days.

The Office initially determined a patent term adjustment of 225 days based on an adjustment for PTO delay of 527 days resulting from 527 days of delay in mailing a non-final office action on June 9, 2006, fourteen (14) months and 527 days after the filing date of the application. The patent term adjustment was reduced by 302 days of applicant delay pursuant to 37 C.F.R. § 1.704~~74~~. Specifically, the patent term adjustment was reduced by 28 days under 37 CFR 1.704(b) for the filing of a response on March 14, 2007, to a non-final Office action mailed on November 14, 2006, which was three (3) months and 28 days after the mailing of the non-final Office action; by 259 days under 37 CFR 1.704(c)(7) for the filing of an amendment correcting an omission on November 28, 2007, 259 days after the

filing of the paper having the omission on March 14, 2007, and by 15 days under 37 CFR 1.704(b), for the filing of a response to a non-final Office action filed on September 14, 2008, which was filed three (3) months and 15 days after the mailing of the non-final Office action on May 30, 2008.

The subject application for patent term adjustment was timely filed on May 2, 2009, prior to payment of the issue fee.¹

Applicants assert that the 259 day period of delay is not warranted because the examiner held that the amendment filed on March 14, 2007 was responsive. Specifically, applicants note that Page 2 of the Office action mailed in response to the corrected amendment filed on November 28, 2007 states that "Applicant's remarks regarding the Election by Original Presentation are persuasive."

37 CFR 1.704(b) states that an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed.

37 CFR 1.704(c)(7) states that circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping: Submission of a reply having an omission (§1.135(c)), in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the reply having an omission was filed and ending

¹ PALM records indicate that the issue fee was paid on May 24, 2009.

on the date that the reply or other paper correcting the omission was filed.

37 CFR 1.111(b) states that in order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a *bona fide* attempt to advance the application or the reexamination proceeding to final action.

37 CFR 1.135(c) states that when reply by the applicant is a *bona fide* attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

At the outset, notwithstanding applicants' assertion that the reply filed on March 14, 2007 was not non-compliant, a review of the record reveals that a reply in compliance with 37 CFR 1.111 was not filed until November 28, 2007, 259 days after the filing of the original reply.

Furthermore, applicants' assertion that the reply of March 14, 2007 was not non-compliant is not persuasive. In this regard, the showing of record is that applicants' additional arguments filed on November 28, 2007 were required in order for the examiner to fully consider the amendment filed on March 14, 2007. The comment in the final Office action mailed on January 23, 2008 that applicants' remarks regarding the Election by Original Presentation are persuasive supports a conclusion that the additional arguments supplied on November 28, 2007 were

required for a complete reply. The showing of record, therefore, is that applicants' reply of March 14, 2007, is a *bona fide* attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted. Once the inadvertently omitted material was supplied, in this case by applicants' reply of November 28, 2007, the reply was complete to the extent that the examiner found applicants' argument to be persuasive. Accordingly, the removal of the period of reduction of 259 days is not warranted.

The response filed on March 14, 2007 was not in compliance with 37 CFR 1.111. Applicants did not file a proper reply until November 28, 2007, and therefore is properly assessed a reduction in patent term adjustment for filing a proper reply three (3) months and 259 days after the filing of the reply on March 14, 2007 having the omission.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application is being forwarded to the Office of Data Management for issuance of a patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this matter should be directed to Douglas I. Wood, Senior Petitions Attorney, at (571) 272-3231.

A handwritten signature in cursive script, appearing to read "Nancy Johnson", followed by a stylized flourish or initial.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions